REMARKS/ARGUMENTS

Entry of this response and reconsideration and allowance of the above-identified patent application are respectfully requested. Please note that an information disclosure statement (IDS) has been filed concurrently with the present response. The Examiner is respectfully requested to consider and initial the cited references.

Claims 1-11 and 18-26 are pending. By this amendment, claims 1, 4, 6, 8, 9, 18, and 23 are amended. Claims 27-29 have been added. No claims are canceled. No new matter is added.

Applicant respectfully submits that, upon entry of the subject amendment, the application will be in condition for allowance. Applicant, thus, respectfully requests consideration of the above amendment and following remarks.

Claims 1-11 and 18-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,282,713 to Kitsukawa ("Kitsukawa") in view of US Pub. No. 2001/0001160 to Shoff ("Shoff") and US Pub. No. 2003/0208758 to Schein ("Schein"). Applicant respectfully traverses the rejection.

Applicant would like to thank Examiner Manning and Examiner Beliveau for conducting an in person interview with Applicants and Applicants' representative. The attendees discussed the disclosure of the prior art, the independent claims, and a potential amendment to the claims. The attendees concluded that the potential amendment would include limitations not found in the prior art relied upon. However, Examiner Manning and Examiner Beliveau indicated that an additional search may be necessary. In summary, the interview was helpful in facilitating and progressing the prosecution of the present application.

Claims 4, 6, 8 and 9 have been amended to clarify the language of these claims. Independent claims 1, 18, and 23 have been amended to include the following limitation, or a variation thereof:

A. wherein the advertising information associated with the displayed icon is targeted based on information of the subscriber;

Among other places, this limitation is supported in the specification at page 10. ("If particular information is known about the subscriber .... targeted advertisements can be provided.") Additionally, claims 27-29 have been added to recite that the information of the subscriber comprises location information of the subscriber.

Furthermore, claim 1 has been amended to remove the previously added language which recited that that displayed icon is independent of the television programming. Instead, independent claims 1, 18, and 23 have been amended to include the following limitation, or a variation thereof:

> B. wherein the displayed icon is not selected for display based on the subject matter of the television program being displayed on the television screen;

During the interview, there was some discussion by the Examiners about the ambiguity of the pending language of claim 1 – "independent of a television program." Consequently, limitation B, above (suggested largely by the Examiner), has been added to the independent claims, which Applicant submits is more clear than the previous language of claim 1. In addition, and as discussed in the interview, none of the cited prior art discloses this claim element.

The Examiners also voiced some concern about whether this limitation is supported in the application. While Applicant does not believe that a 35 U.S.C. §112 rejection is credible or likely, this concern will be addressed in order to expedite allowance of the present application.

There are many places in the specification that clearly support the subject matter of the added claim language of the claimed invention. For example, the specification states that in one embodiment the system may include a cable box 20 channel selector. Page 7, line 7. The cable box 20 is shown in Figures 1 and 2 and, in this embodiment, is separate from the set top box 30. As stated in the specification, "Television 10 has a screen 12 which displays an image depending on the channel selected using the cable box 20." Page 7, lines 29-30. In summary, in

this embodiment the cable box 20 is used by the subscriber to select the television channel in order to watch the desired television program.

As shown in Figure 2, the cable box 20 is disposed between the set top box 30 and the TV 10. Because the selection of the television program occurs downstream from the set top box 30 at the cable box 20, the set top box 30 has no means of determining what television program is being displayed on the television screen. Thus, if the set top box does not know what television program is being displayed, one skilled in the art **must** conclude that the displayed icons are not selected for display based on the subject matter of the television program.

Applicant therefore submits that the claimed subject matter is disclosed in the specification in such a way as to reasonably convey to one skilled in the art that Applicant had possession of the claimed invention.

Furthermore, the specification at page 9, lines 7-12 states that in one embodiment the displayed icons change to new icons every 2 minutes. If the icons are associated with the TV programming shown, the icons could not change at fixed time intervals, but instead would need to change when the user changes channels to view different television programs. Thus, one skilled in the art must conclude that the displayed icons are not selected for display based on the subject matter of the television program displayed.

Accordingly, the specification supports the amended language of claims 1, 18, and 23 (e.g., wherein the displayed icon is not selected for display based on the subject matter of the television program being displayed on the television screen") in such a way as to reasonably convey to one skilled in the art that Applicant had possession of the claimed invention.

In the Office Action, claims 1-11 and 18-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kitsukawa in view of Shoff and Schein. The Office Action concedes that both Kitsukawa and Shoff fail to disclose "that the icon and advertising information are independent of the television program being displayed." Office Action page 3. The Office Action relies on paragraphs 74-75 of Schein as teaching that the advertising icon is unassociated with the programming being shown.

As discussed above, independent claim 1 has been amended to require:

> wherein the displayed icon is not selected for display based on the subject matter of the television program being displayed on the television screen;

Independent claims 18 and 23 have been similarly amended. Referring to the citation relied upon by the Office Action, Schein discloses that the advertising is targeted according to the programming:

> This type of advertising allows the advertiser to directly target a particular program, . . . "

(Schein at para. 75). Applicant submits that none of the prior art relied upon, including Schein, discloses the displayed icon not being selected for display based on the subject matter of the television program being displayed on the television screen as required by the amended claims.

In addition and as discussed above, independent claim 1 has been amended to require:

> wherein the advertising information associated with the displayed icon is targeted based on information of the subscriber;

Independent claims 18 and 23 have been similarly amended. As discussed in the interview, none of the prior art relied upon in the Office Action discloses advertising targeted based on information of the subscriber.

Finally, when a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. Applicant submits that there is no motivation to combine the references relied upon and none is provided in the Office Action.

In addition, the references teach away from the claimed invention as amended. Specifically, all the references relied upon disclose targeting the advertisements according to the television programming, which teaches away from claims which require the displayed icon not be selected for display based on the subject matter of the television program being displayed on the television screen.

Further, Kitsukawa is wholly concerned with displaying icons that are related to items shown in the scene. Therefore, it would be inappropriate to combine Kitsukawa with another reference to arrive at the claimed invention.

Applicant therefore respectfully submits that independent claims 1, 18 and 23 are patentable over the prior art. In addition, because a claim that is dependent from a patentably distinct claim is also patentably distinct, Applicant respectfully requests allowance of claims 2-11 and 29,which depend from claim 1, claims 19-22 and 28, which depend from claim 18, and claims 24-27, which depend from claim 23.

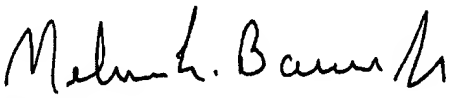
In view of the foregoing, it is respectfully submitted that the claimed invention is patentably distinguished over the asserted prior art references and that the application stands in condition for allowance. It is respectfully requested that the application be reconsidered, that all pending claims be allowed, and that the application be passed to issue.

CONCLUSION

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact Mel Barnes at (301) 581-0081, to discuss any other changes deemed necessary in a telephonic interview.

Authorization is hereby granted to charge any deficiencies in fees, including any fees for extension of time under 37 C.F.R. §1.136(a), to Deposit Account 50-0687. Please credit any overpayment in fees to the same deposit account.

Date: April 18, 2006



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